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FORM PTO-1595

1-31-92

RECORDATION

PATENT

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Transmit or copy thereof.

1. Name and Address of Conveying Party(ies):

Purdue Research Foundation
1291 Cumberland Avenue
West Lafayette, IN 47906

2. Name and Address of receiving Party(ies):

Name: The Texas A&M University System

Internal Address:

Street Address: 707-A Texas Avenue, Suite 201

City: College Station

State: Texas Zip: 77843

Entity/State: Texas State Agency

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

Additional name(s) & address(es)

☐ Yes ☒ No

attached?

3. Nature of conveyance:

☒

Assignment

☐ Merger☐ Security Agreement☐ Change of Name☐ Other

Effective Date: November 7, 2000

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

B. Patent No.(s) 5,865,754

Additional Numbers attached?

☐ Yes ☒ No

5. Name and address of party to whom correspondence

concerning document should be mailed:

Name: Bradley P. Williams, Esq.

Internal Address: Baker & Botts, L.L.P.

Street Address: 2001 Ross Avenue

City: Dallas

State: Texas Zip: 75201

6. Total number of applications and patents involved: One (1)

7. Total Fee (37 CFR 3.41): \$40.00

☒

Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

(Attach Duplicate Copy of this page if paying by deposit account)

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Bradley P. Williams

Name of Person Signing

Signature

Date

Total number of pages including cover sheet

9

OMB No. 0651-0011 (exp.4/94)

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01/31/2001 AAHMEB1 00000025 5865754

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INTERINSTITUTIONAL AGREEMENT

Between

Purdue Research Foundation

And

The Texas A&M University System

THIS INTERINSTITUTIONAL AGREEMENT is made and entered into by and between Purdue Research Foundation, West Lafayette, Indiana, 47907 (hereinafter referred to as "PRF"), and The Texas A&M University System, College Station, Texas 77843-3369 (hereinafter referred to as the "SYSTEM").

WITNESSETH:

WHEREAS, PRF is owner of U.S. Patent Number 5,865,754 granted 2/2/1999 entitled, "Fluorescence Imaging System and Method" and of related patent applications, as described in Appendix A (all hereinafter referred to as "PRF Imaging Technology"), developed by Professor Eva Sevick-Muraca, formerly Associate Professor of Chemical Engineering at Purdue University, and Dilip Y. Paithankar, Tamara L. Troy, Christina Hutchinson, and Jeffery S. Reynolds of Purdue University, and;

WHEREAS, PRF has entered into an Option Agreement with Mallinckrodt, Inc., granting to Mallinckrodt, Inc. the option to obtain an exclusive license to PRF Imaging Technology in the field-of-use of veterinary and human pathology imaging or detection; and

WHEREAS, in the Option Agreement with Mallinckrodt, Inc., PRF retained the right to assign the PRF Imaging Technology and the Option Agreement to the SYSTEM;

WHEREAS, Dr. Eva Sevick-Muraca is now a Professor in the Chemical Engineering Department at Texas A&M University and a researcher in the Chemical Engineering Division of the Texas Engineering Experiment Station, both components of the SYSTEM; and

WHEREAS, Dr. Eva Sevick-Muraca will continue to conduct research and development at the SYSTEM in the area of imaging technology; and

WHEREAS, both PRF and SYSTEM desire to transfer intellectual property rights related to the PRF Imaging Technology in SYSTEM to facilitate the continued research and development of the imaging technology, and to promote the commercialization of the consolidated intellectual property rights, for the benefit of the public.

NOW THEREFORE, in consideration of the foregoing and the mutual covenants and promises contained herein, the receipt and sufficiency of which is hereby acknowledged, this Interinstitutional Agreement is made by PRF and the SYSTEM to establish the rights and obligations of PRF and the SYSTEM with respect to the PRF Imaging Technology and the Option Agreement with Mallinckrodt, Inc.

TAY

ARTICLE I – DEFINITIONS

- 1.01 “PRF Imaging Technology” shall mean U.S. Patent Number 5,865,754 granted 2/2/1999 entitled, “Fluorescence Imaging System and Method,” and related patent applications, as described in Appendix A.
- 1.02 “Option Agreement” shall mean the Option Agreement of May 12, 2000 entered into between Mallinckrodt, Inc. and Purdue Research Foundation granting to Mallinckrodt, Inc. certain rights in PRF Imaging Technology.
- 1.03 “Effective Date” shall mean the date this Agreement is executed by both parties hereto.

ARTICLE II – TRANSFER OF RIGHTS

- 2.01 Assignment, PRF Imaging Technology. PRF hereby assigns all right, title and interest in the PRF Imaging Technology to SYSTEM. Upon the Effective Date, PRF shall cooperate with SYSTEM to effect the filing of formal assignment documentation with the U.S. Patent and Trademark Office, as well as comparable foreign offices, for recordation of the title assignment in patent rights to SYSTEM. Furthermore, PRF shall cooperate with SYSTEM to effect the transfer of file wrappers for all patent applications comprising PRF Imaging Technology from the law firm of Woodard, Emhardt, Naughton, Moriarty & McNett (Indianapolis, Indiana) to the law firm designated by SYSTEM. PRF shall pay any costs incurred in the transfer of the file wrappers, subject to reimbursement by SYSTEM in accordance with paragraph 3.02 below.
- 2.02 Assignment, Option Agreement. PRF hereby assigns all right, title and interest in the Option Agreement to SYSTEM. Upon the Effective Date, all rights and obligations of PRF under the Option Agreement shall be conferred to SYSTEM, and PRF shall thereupon have no further obligation with respect to Option Agreement.
- 2.03 Option Fee. The parties understand and agree that prior to the Effective Date of this Agreement, PRF received payment of \$20,000 in exchange for the Option Agreement with Mallinckrodt, that said payment is not subject to this Agreement, and that PRF will distribute net revenue from said payment under Purdue University’s Intellectual Property Policy.
- 2.04 Retained Rights. PRF and Purdue University retain the royalty-free, non-exclusive right to use the PRF Imaging Technology for educational and research purposes only. Research purposes include the right to conduct sponsored research on behalf of for-profit entities, except that PRF may not grant rights in PRF Imaging Technology to such research sponsors; commercial use of the results of such sponsored research shall require such research sponsor to obtain a separate license to PRF Imaging Technology from SYSTEM. SYSTEM does not represent that such separate license will be available or shall be granted to such research sponsor.
- 2.05 Reassignment of Patents. Should SYSTEM decide to abandon any patents or patent applications encompassed by PRF Imaging Technology, SYSTEM shall first offer to reassign said patents or patent applications to PRF. Said offer will be made at least six (6) months prior to any date at which time the patent or patent applications are or become abandoned. Any reassigned patents or patent applications will not be subject to this Agreement.

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ARTICLE III – CONSIDERATION & SYSTEM RESPONSIBILITIES

- 3.01 Technology Development. In consideration for the transfer of rights made by PRF hereinabove, SYSTEM agrees to use all reasonable efforts to accomplish continued development of the technology comprising PRF Imaging Technology for the benefit of the public.
- 3.02 Reimbursement of Patent Expenses. As additional consideration for the transfer made by PRF above, SYSTEM agrees to reimburse PRF for a) any outstanding and unreimbursed patent expenses, if any, incurred as of the Effective Date, and b) reasonable costs incurred in transfer of patent application file wrappers from the firm of Woodard, Emhardt, Naughton, Moriarty & McNett (Indianapolis, Indiana) to the law firm designated by SYSTEM. Reimbursement of such patent expenses shall be provided by SYSTEM no later than sixty (60) days after receipt of an invoice from PRF.
- 3.03 Commercialization. SYSTEM agrees to use all reasonable efforts to accomplish commercialization of the PRF Imaging Technology for public benefit through the licensing of the PRF Imaging Technology to one or more commercial companies. Gross Income which may be received by SYSTEM from such licensing shall be distributed in accordance with the process described below. As used below, the term Gross Income shall mean any money actually received by the SYSTEM as license revenue from the licensing of the PRF Imaging Technology to one or more third parties, including but not limited to Mallinckrodt, Inc.
- a. First, SYSTEM shall recover from Gross Income its unreimbursed funds expended for continued prosecution and maintenance of the patent rights for PRF Imaging Technology, if any, including amounts paid to PRF in accordance with paragraph 3.02 above.
 - b. Second, after deduction of patent expenses as set forth in subparagraph 3.03a., if any, one-third (1/3) of the balance shall be distributed to PRF for distributions to the inventors of the PRF Imaging Technology under PRF's Intellectual Property Policy, and as agreed among the subject inventors. PRF hereby confirms and represents that the funds received from PRF from SYSTEM for inventor distribution shall be paid to inventors in accordance with the terms of this Agreement.
 - c. Third, after implementing the two steps described above, SYSTEM shall distribute forty-two and one-half percent (42.5%) of the balance to PRF solely for the benefit of Purdue University.

The parties understand and agree that claims issued on PRF Imaging Technology may dominate any claims issued on improvements to the technology and that improvements may be required to achieve commercial viability of the technology. Therefore, the parties also understand and agree that SYSTEM may need to make reasonable judgements as to the relative values to licenses that are contributed by PRF Imaging Technology and improvements. SYSTEM agrees to notify PRF in writing of its reasoning for said judgements prior to any distributions under this paragraph 3.03.

- 3.04 Responsibilities of Option Agreement. SYSTEM hereby accepts and confirms that upon the Effective Date, it shall assume all obligations and responsibilities originally held by PRF under the Option Agreement, as if SYSTEM had been the original signatory to the Option Agreement, including but not limited to the obligations to conduct negotiations of the expected license agreement in accordance with paragraph 10 of the Research Agreement entered between PRF and Mallinckrodt, Inc. on September 15, 1994.
- 3.05 Government Rights. SYSTEM hereby accepts and confirms that upon the Effective Date, it shall assume all obligations and responsibilities to the U.S Government originally held by PRF under 37CFR401.14(a), as if SYSTEM had been the original grantee under the contracts or grants received by Purdue from the Federal Government for sponsorship of the PRF Imaging Technology.

- 3.06 Patent Maintenance and Prosecution. SYSTEM agrees to use all reasonable efforts to maintain the issued patents for PRF Imaging Technology, and to obtain the broadest and strongest scope of patent protection for PRF Imaging Technology, subject to paragraph 2.05. SYSTEM will provide copies to PRF of all correspondence with patent offices regarding prosecution of applications and maintenance of the patents.

ARTICLE IV - PAYMENTS AND REPORTS

- 4.01 Commercialization Reports. Within sixty (60) days following the close of each Calendar Year, SYSTEM shall deliver to the PRF a letter report as to SYSTEM's efforts and accomplishments during the preceding year in the further development and/or commercialization of PRF Imaging Technology.
- 4.02 Inventors' Income. SYSTEM represents that it shall provide payment of any amounts due PRF on behalf of inventors under paragraph 3.04(b) above within thirty (30) days of its receipt of such income from a licensee. Furthermore, PRF represents that it shall provide payment of any such amounts due inventors under paragraph 3.04 (b) above within thirty (30) days of its receipt of such payment from SYSTEM.
- 4.03 Other Considerations Due PRF. Any amounts due the PRF under paragraphs 3.04(c) above shall be paid to PRF on a semi-annual basis, no later than July 31 for the period January-to-June, and January 31 for the period July-to-December. SYSTEM shall provide information sufficient to allow PRF to calculate the amounts due for that semi-annual period.
- 4.04 Inspection of Books and Records. At its own expense, PRF may inspect SYSTEM's books and records up to twice a year to determine amounts payable to the PRF. SYSTEM shall maintain such books and records for at least three (3) years following the dates of the underlying transactions. Any such inspections shall be in confidence and conducted during ordinary business hours. PRF will provide SYSTEM notice of two (2) weeks before making such inspections. PRF may employ a Certified Public Accountant for this purpose.

ARTICLE V - EFFECTIVE DATE AND TERM

- 5.01 Effective Date. This Agreement shall become effective upon the signatures of duly authorized representatives of both PRF and SYSTEM.
- 5.02 Term and Expiration. This Agreement shall expire automatically upon (i) the expiration of the last to expire patent comprising PRF Imaging Technology and (ii) final payment of all considerations required hereunder.

ARTICLE VI - REPRESENTATIONS, WARRANTIES AND LIABILITY

- 6.01 Liability and Indemnification. SYSTEM represents that it shall expressly require in any license agreement to PRF Imaging Technology that the licensee shall indemnify, defend and hold harmless PRF, Purdue University, their regents, officers, and employees, against any claim, proceeding, demand, liability, or expenses (including legal expenses and attorney's fees) which relates to injury to persons or property, or against any other claim, proceeding, demand, expense and liability of any kind whatsoever resulting from the production, manufacture, sale, use, lease, consumption or advertisement of products made, used or sold under patents comprising PRF Imaging Technology.

Appendix A

Title:

Fluorescence Imaging System and Method
(U.S. Issued Patent Title)

Fluorescence Lifetime-Based Imaging and Spectroscopy in Tissues and Other Random Media
(PCT Patent Application Title)

<u>Purdue Ref. No.</u>	<u>Serial/Patent No.</u>	<u>Country</u>	<u>Date Filed / Issued</u>
P-95017.P1.US	Ser. No. 60/002,746	United States - Provisional	8/24/95
P-95017.00.US	Pat. No. 5,865,754	United States	2/2/99
P-95017.00.WO	Ser. No. PCT/US96/13658	PCT Closed – Nationalized	8/23/96
P-95017.00.CA	Ser. No. 2230228	Canada	8/23/96
P-95017.00.CN	Ser. No. 96197632.2	China – Abandoned	8/23/96
P-95017.00.EP	Ser. No. 96929029.5	Europe	8/23/96
P-95017.00.JP	Ser. No. 510471/97	Japan	8/23/96
P-95017.00.MX	Ser. No. 981351	Mexico	8/23/96
P-95017.00.NO	Ser. No. 980750	Norway	8/23/96

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